



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/091,000	03/04/2002	Robert Degen	20375-008700	6763

20350 7590 07/24/2006

TOWNSEND AND TOWNSEND AND CREW, LLP
TWO EMBARCADERO CENTER
EIGHTH FLOOR
SAN FRANCISCO, CA 94111-3834

EXAMINER

SHERR, CRISTINA O

ART UNIT PAPER NUMBER

3621

DATE MAILED: 07/24/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/091,000

Applicant(s)

DEGEN ET AL.

Examiner

Cristina Owen Sherr.

Art Unit

3621

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 23 May 2006.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-4, 6-14, 16-19 and 21-27 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-4, 6-14, 16-19, 21-27 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

DETAILED ACTION

1. This communication is in response to applicant's after-final amendment filed May 23, 2006. Claims 5, 15, and 20 have been canceled. Claims 1, 4, 6-9, 23 and 27 have been amended. Claims 1-4, 6-14, 16-19, 21-27 are pending in this case.

Response to Arguments

2. Applicant's arguments with respect to claims 1-4, 6-14, 16-19, 21-27 have been considered but are moot in view of the new ground(s) of rejection. Thus, the finality of the last action is withdrawn.

Claim Rejections - 35 USC § 103

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claims 1-4, 6-14, 16-19, 21-27 are rejected under 35 U.S.C. 103(a) as being unpatentable over Stewart et al (US 2003/0135457).

5. Regarding claim 1—

Stewart discloses: a method for evaluating electronic value transfers (e.g. par 0016), the method comprising: receiving a plurality of money transfer requests, wherein the money transfer requests include a first sender identification associated with a first money transfer request and at least a second sender identification associated with a second money transfer request (e.g. par 52).

Art Unit: 3621

electronically storing records of the money transfer requests (e.g. par 42); performing an analysis of the records, wherein the analysis indicates the first sender identification and the second sender identification are related (e.g. par 37); creating a reference designator, wherein the reference designator is associated with the first sender identification and the second sender identification (e.g. par 21); and searching the records of the money transfer requests according to a specified criteria to determine if any of the money transfer requests associated with the reference designator are suspicious money transfer requests (e.g. par 21); flagging any suspicious money transfer requests (e.g. par 21). Page 3

6. Stewart does not specifically refer to money requests or money transfers as "suspect" or "suspicious"; however, it does refer to "fraudulent" or "fraud". Merely changing terminology does not confer patentability when said different terms are functionally the same. Additionally, Stewart does not specifically refer to criteria used in the instant application when determining that a transaction is suspect. However, Stewart does refer to "An automated search routine within the authorization system 60 also checks customer data against restricted lists published by the United States Treasury Department Office of Foreign Assets Control (OFAC) to maintain OFAC compliance. This search includes enhanced name/foreign translation mapping to provide matching capabilities with low false-positive responses." (par 0021). The criteria used in the instant application could easily be substituted for the ones named in Stewart. Thus, it would be obvious to

in the instant application when determining that a transaction is

Art Unit: 3621

one of ordinary skill in the art to adapt Stewart and thus obtain the instant application.

7. Regarding claims 2-4 –

As above, Stewart does not specifically refer to money requests or money transfers as “suspect” or “suspicious”, however, it does refer to “fraudulent” or “fraud”. Merely changing terminology does not confer patentability when said different terms are functionally the same. Additionally, Stewart does not specifically refer to criteria used in the instant application when determining that a transaction is suspect. However, Stewart does refer to “An automated search routine within the authorization system 60 also checks customer data against restricted lists published by the United States Treasury Department Office of Foreign Assets Control (OFAC) to maintain OFAC compliance. This search includes enhanced name/foreign translation mapping to provide matching capabilities with low false-positive responses.” (par 0021). The criteria used in the instant application could easily be substituted for the ones named in Stewart. Thus, it would be obvious to one of ordinary skill in the art to adapt Stewart and thus obtain the instant application.

8. Regarding claims 6-14 –

As above, Stewart does not specifically refer to money requests or money transfers as “suspect” or “suspicious”, however, it does refer to “fraudulent” or “fraud”. Merely changing terminology does not confer patentability when said different terms are functionally the same. Additionally, Stewart does not specifically refer to criteria used in the instant application when determining that a transaction is suspect. However, Stewart does refer to “An automated search routine within the authorization system 60 also checks customer data against restricted lists published by the United States Treasury Department Office of Foreign Assets Control (OFAC) to maintain OFAC compliance. This search includes enhanced name/foreign translation mapping to provide matching capabilities with low false-positive responses.” (par 0021). The criteria used in the instant application could easily be substituted for the ones named in Stewart. Thus, it would be obvious to one of ordinary skill in the art to adapt Stewart and thus obtain the instant application.

Art Unit: 3621

transaction is suspect. However, Stewart does refer to "An automated search routine within the authorization system 60 also checks customer data against restricted lists published by the United States Treasury Department Office of Foreign Assets Control (OFAC) to maintain OFAC compliance. This search includes enhanced name/foreign translation mapping to provide matching capabilities with low false-positive responses." (par 0021). The criteria used in the instant application could easily be substituted for the ones named in Stewart. Thus, it would be obvious to one of ordinary skill in the art to adapt Stewart and thus obtain the instant application.

9. Regarding claim 16 –

Stewart discloses a method for evaluating electronic value transfers (e.g. par 16), the method comprising: accessing a money transfer record, wherein the money transfer record includes a sender identification and a receiver identification (e.g. par 52); assigning a master location identifier to the money transfer record, wherein the master location identifier is determined by one or both of the sender identification and the receiver identification (e.g. par 21); comparing the money transfer record to a reference designator using a specified criteria, wherein one or more fields of the reference designator or the money transfer record indicate a relationship between the reference designator and the money transfer record (e.g. par 21); and associating the money transfer record with the reference designator (e.g. par 21).

10. As above, Stewart does not specifically refer to money requests or money transfers as "suspect" or "suspicious", however, it does refer to "fraudulent" or

Art Unit: 3621

"fraud". Merely changing terminology does not confer patentability when said different terms are functionally the same. Additionally, Stewart does not specifically refer to criteria used in the instant application when determining that a transaction is suspect. However, Stewart does refer to "An automated search routine within the authorization system 60 also checks customer data against restricted lists published by the United States Treasury Department Office of Foreign Assets Control (OFAC) to maintain OFAC compliance. This search includes enhanced name/foreign translation mapping to provide matching capabilities with low false-positive responses." (par 0021). The criteria used in the instant application could easily be substituted for the ones named in Stewart. Thus, it would be obvious to one of ordinary skill in the art to adapt Stewart and thus obtain the instant application.

11. Regarding claim 17 –

Stewart discloses a method for iteratively compiling suspicious money transfer activities from money transfer records (e.g. par 16), the method comprising: accessing a first money transfer record (e.g. par 52); providing a first reference designator, wherein the first reference designator is associated with one or more of a sender identification and a receiver identification from a second money transfer record (e.g. par 21); comparing the first money transfer record to the first reference designator using a specified criteria, wherein the comparison indicates the first money transfer record is not related to the first reference designator (e.g. par 21); and creating a second reference designator, wherein the second

Art Unit: 3621

reference designator is associated with one or more of a sender identification and a receiver identification from the first money transfer record (e.g. par 21).

12. As above, Stewart does not specifically refer to money requests or money transfers as "suspect" or "suspicious", however, it does refer to "fraudulent" or "fraud". Merely changing terminology does not confer patentability when said different terms are functionally the same. Additionally, Stewart does not specifically refer to criteria used in the instant application when determining that a transaction is suspect. However, Stewart does refer to "An automated search routine within the authorization system 60 also checks customer data against restricted lists published by the United States Treasury Department Office of Foreign Assets Control (OFAC) to maintain OFAC compliance. This search includes enhanced name/foreign translation mapping to provide matching capabilities with low false-positive responses." (par 0021). The criteria used in the instant application could easily be substituted for the ones named in Stewart. Thus, it would be obvious to one of ordinary skill in the art to adapt Stewart and thus obtain the instant application.

13. Regarding claims 18-19-

As above, Stewart does not specifically refer to money requests or money transfers as "suspect" or "suspicious", however, it does refer to "fraudulent" or "fraud". Merely changing terminology does not confer patentability when said different terms are functionally the same. Additionally, Stewart does not specifically refer to criteria used in the instant application when determining that a transaction is suspect. However, Stewart does refer to "An automated search

Art Unit: 3621

routine within the authorization system 60 also checks customer data against restricted lists published by the United States Treasury Department Office of Foreign Assets Control (OFAC) to maintain OFAC compliance. This search includes enhanced name/foreign translation mapping to provide matching capabilities with low false-positive responses." (par 0021). The criteria used in the instant application could easily be substituted for the ones named in Stewart. Thus, it would be obvious to one of ordinary skill in the art to adapt Stewart and thus obtain the instant application.

14. Regarding claims 21-22 — Page 8

As above, Stewart does not specifically refer to money requests or money transfers as "suspect" or "suspicious", however, it does refer to "fraudulent" or "fraud". Merely changing terminology does not confer patentability when said different terms are functionally the same. Additionally, Stewart does not specifically refer to criteria used in the instant application when determining that a transaction is suspect. However, Stewart does refer to "An automated search routine within the authorization system 60 also checks customer data against restricted lists published by the United States Treasury Department Office of Foreign Assets Control (OFAC) to maintain OFAC compliance. This search includes enhanced name/foreign translation mapping to provide matching capabilities with low false-positive responses." (par 0021). The criteria used in the instant application could easily be substituted for the ones named in Stewart. Thus, it would be obvious to one of ordinary skill in the art to adapt Stewart and thus obtain the instant application.

Art Unit: 3621

15. Regarding claim 23 –

Stewart discloses a method for evaluating electronic value transfers (e.g. par 16), the method comprising: receiving money transfer requests, wherein the money transfer requests include a user identification associated each of the money transfer requests (e.g. par 52); electronically storing records of the money transfer requests (e.g. par 41); providing the records of the money transfer requests to a fraud processing computer (e.g. par 21).

16. As above, Stewart does not specifically refer to money requests or money transfers as “suspect” or “suspicious”, however, it does refer to “fraudulent” or “fraud”. Merely changing terminology does not confer patentability when said different terms are functionally the same. Additionally, Stewart does not specifically refer to criteria used in the instant application when determining that a transaction is suspect. However, Stewart does refer to “An automated search routine within the authorization system 60 also checks customer data against restricted lists published by the United States Treasury Department Office of Foreign Assets Control (OFAC) to maintain OFAC compliance. This search includes enhanced name/foreign translation mapping to provide matching capabilities with low false-positive responses.” (par 0021). The criteria used in the instant application could easily be substituted for the ones named in Stewart. Thus, it would be obvious to one of ordinary skill in the art to adapt Stewart and thus obtain the instant application.

17. Regarding claim 24 –

Stewart discloses a method for evaluating electronic value transfers (e.g. par 16), the method comprising: receiving money transfer requests, wherein the money transfer requests include a user identification associated each of the money transfer requests (e.g. par 52); electronically storing records of the money transfer requests (e.g. par 41); providing the records of the money transfer requests to a fraud processing computer (e.g. par 21).

Art Unit: 3621

Stewart discloses a system for evaluating value transfers (e.g. par 16), the system comprising: a fraud processing computer (e.g. par 21); and a computer readable medium associated with the fraud processing computer, wherein the computer readable medium comprises computer instructions executable by the fraud processing computer to: access a first money transfer record (e.g. par 52); provide a first reference designator, wherein the first reference designator is associated with one or more of a sender identification and a receiver identification from a second money transfer record (e.g. par 21); compare the first money transfer record to the first reference designator using a specified criteria (e.g. par 21).

18. As above, Stewart does not specifically refer to money requests or money transfers as "suspect" or "suspicious"; however, it does refer to "fraudulent" or "fraud". Merely changing terminology does not confer patentability when said different terms are functionally the same. Additionally, Stewart does not specifically refer to criteria used in the instant application when determining that a transaction is suspect. However, Stewart does refer to "An automated search routine within the authorization system 60 also checks customer data against restricted lists published by the United States Treasury Department Office of Foreign Assets Control (OFAC) to maintain OFAC compliance. This search includes enhanced name/foreign translation mapping to provide matching capabilities with low false-positive responses." (par 0021). The criteria used in the instant application could easily be substituted for the ones named in Stewart.

Art Unit: 3621

Thus, it would be obvious to one of ordinary skill in the art to adapt Stewart and thus obtain the instant application.

19. Regarding claims 25-26 –

As above, Stewart does not specifically refer to money requests or money transfers as “suspect” or “suspicious”, however, it does refer to “fraudulent” or “fraud”. Merely changing terminology does not confer patentability when said different terms are functionally the same. Additionally, Stewart does not specifically refer to criteria used in the instant application when determining that a transaction is suspect. However, Stewart does refer to “An automated search routine within the authorization system 60 also checks customer data against restricted lists published by the United States Treasury Department Office of Foreign Assets Control (OFAC) to maintain OFAC compliance. This search includes enhanced name/foreign translation mapping to provide matching capabilities with low false-positive responses.” (par 0021). The criteria used in the instant application could easily be substituted for the ones named in Stewart. Thus, it would be obvious to one of ordinary skill in the art to adapt Stewart and thus obtain the instant application.

20. Regarding claim 27 –

Stewart discloses a system for transferring value (e.g. par 16), the system comprising: a money transfer system (e.g. par 16); and a fraud processing server communicably coupled to the money transfer system wherein money transfer records associated with the money transfer system are accessible by the fraud

Art Unit: 3621

processing server to identify any suspect suspicious money transfer requests (e.g. par 21).

21. As above, Stewart does not specifically refer to money requests or money transfers as "suspect" or "suspicious", however, it does refer to "fraudulent" or "fraud". Merely changing terminology does not confer patentability when said different terms are functionally the same. Additionally, Stewart does not specifically refer to criteria used in the instant application when determining that a transaction is suspect. However, Stewart does refer to "An automated search routine within the authorization system 60 also checks customer data against restricted lists published by the United States Treasury Department Office of Foreign Assets Control (OFAC) to maintain OFAC compliance. This search includes enhanced name/foreign translation mapping to provide matching capabilities with low false-positive responses." (par 0021). The criteria used in the instant application could easily be substituted for the ones named in Stewart. Thus, it would be obvious to one of ordinary skill in the art to adapt Stewart and thus obtain the instant application.

22. Examiner's note: Examiner has cited particular columns and line numbers in the references as applied to the claims above for the convenience of the applicant. Although the specified citations are representative of the teachings in the art and are applied to the specific limitations within the individual claim, other passages and figures may be applied as well. It is respectfully requested from the applicant, in preparing the responses, to fully consider the references in

Art Unit: 3621

entirety as potentially teaching all or part of the claimed invention as well as the context of the passage as taught by the prior art or disclosed by the examiner.

Conclusion

23. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Cristina Owen Sherr whose telephone number is 571- 272-6711. The examiner can normally be reached on 8:30-5:00 Monday through Friday.

24. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, James Trammell can be reached on 571-272-6712. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

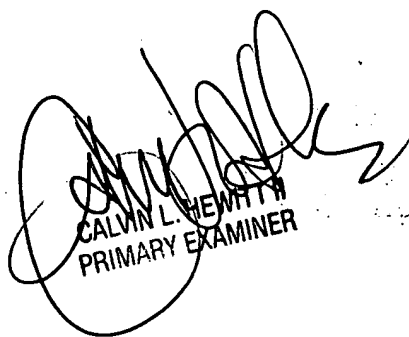
25. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Application/Control Number: 10/091,000

Page 14

Art Unit: 3621

COS, 07/17/06


CALVIN L. HEWITT
PRIMARY EXAMINER